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26582 7590 03/08/2007 HOLLAND & HART, LLP P.O BOX 8749 DENVER, CO 80201			EXAMINER INGBERG, TODD D	
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			2193	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/998,415

Applicant(s)

WIGINTON ET AL.

Examiner

Todd Ingberg

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2193

DETAILED ACTION

Claim Status

Claims 1 – 13 and 21 - 32 have been examined.

Claims 14 – 20 have been canceled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. “First User” critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

3. The term “*complex software packages*” has no support in the Specification to make a determination of what is complex and what is not complex. This limitation has no patentable weight. What is deemed complex to one of ordinary skill in the art may not be deemed complex by another of ordinary skill in the art.

These terms fail to provide a quantifiable distinction and are subject to opinion and speculation. These terms hold no patentable weight.

4. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “installing”, does not reasonably provide enablement for “implementing”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to software installation, the invention

Art Unit: 2193

commensurate in scope with these claims. The Applicant has introduced the term “implement” or implementation while replacing the term install and installation. The Specification on page 6 has the word “**implementation**” but the word is not a term in the context to the invention only in a legal context.

5. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**implementation**” and “**implement**” are not supported in the Specification. These terms are new matter.

6. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**independent module**” is not supported in the original disclosure and is deemed new matter.

7. Claims 1 – 7 and 29 - 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations containing the following: wherein later addition of independent modules uses the solicited information from the non-expert user to ensure the later

Art Unit: 2193

addition independent modules are implemented consistent with the software package and at least the first information relating to the a user, are not supported in the original disclosure and is deemed new matter. Claim 7 contains “*intermediate user*” (deleted from claims 21 and 29). which is not supported. How “*ensuring*” is performed as claimed with “ensure the later addition independent modules are implemented consistent with the software package” is new matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Profit as documented in “The Official Software Companion Microsoft Profit”, Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**).

Claim Interpretation for All Claims

“*Intended Use*” as in the intended User has no patentable weight.

Claim 1

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C), by an expert for use by a und user to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, Chapter 2, page 33, Select Business Type Figure 2-1 , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 26, 33 and 228-229);
entering by the expert at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33, and 228-229 as per above the select business type , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the at least one question entered by the expert being designed to solicit at least first information from an non-expert end user relating to a business of the end user (**Profit1**, pages 33 and 228-229, entry is a response to question , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user);

Art Unit: 2193

determining whether additional information relating to the business of the non-expert end user is necessary to implement a the software package on a computer system of the end user (**Profit1**, page 35, select from Figure 2-2 determination made if Figure 2-3 is needed – the actual software installed is determined by the answer to the questions, , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, pages 26, 33, and 228-229 as per above the select business type);

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 35, NEXT button on the bottom of screen);
if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user (**Profit1**, page 26 and 35, Business set up to set up the components requested); and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user (**Profit1**, page 26 and 35, Business set up to set up the components requested - , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

Claim 3

The method of claim 1, including the step of: saving the at least one question prior to a determination that additional information is not necessary. (**Profit1**, page 227, must determine where to install, Figure 8-2).

Claim 4

The method of claim 1, including the step of: providing links to help files (**Profit1**, pages 24 - 28, Help Contents), wherein such help files assist the non-expert end user in providing at least one response to the at least one question, the at least one response relating to the business of the non-expert end user (**Profit1**, page 26 and 35, Business set up to set up the components requested - , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

Claim 5

The method of claim 4, further comprising the step of providing at least one derived response for the at least one question, the at least one derived response corresponding to a generally accepted accounting principle. . (**Profit1**, page 66 – 68, General Ledger and Fiscal periods and year).

Claim 7

Profit1 anticipates an apparatus for enabling the development of **implementation** installation software wizards **for complex software packages comprising at least one independent**

Art Unit: 2193

module (Profit1, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1), comprising: at least one memory; at least one executable file stored in the at least one memory; the at least one executable file comprising at least one instruction for providing at least one question definition screen (**Profit1**, Chapter 2, page 33, Description of Company, Figure 2-1); a monitor; at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user (**Profit1**, page 33, Description of Company, Figure 2-1 – This is a Wizard); the at least one processing unit includes at least one input so the at least one intermediate user can input at least a first question (**Profit1**, page 33, Responding to the question on page 33), the first question to solicit information from an end user relating to a business of the end user (**Profit1**, page 33, Description of Company, Figure 2-1); such that the end user can input business information specific to the end user (**Profit1**, page 35, Figures 2-2 and 2-3); and a compiler to write all the received information (**Profit1**, page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions), wherein the received information is saved for the end user (**Profit1**, page 34, After the NEXT button is selected the information is saved the next part of the Wizard asks Company level information and page 75 end of questions mentions double checking your work and storing), wherein execution of the executable file solicits information from the end user to set options in and implement the **at least one independent module of the complex software package (Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

Claim 9

The apparatus of claim 7, wherein the at least one memory comprises at least one help file. (Profit1, pages 22 – 23, reference book stored in the computer's memory).

Claim 10

The apparatus of claim 7, wherein the at least one processing unit includes a security module. (Profit1, page 36 – 38, Passwords and controlling access is a Security Module).

Claim 11

Profit1 anticipates a computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop implementation installation software wizards set up by an expert to assist a end users in installing business related **complex software packages (Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1, The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), comprising **at least one independent module** on a computer system of an end user (**Profit1**, page 33, Select Business Type Figure 2-1, The Microsoft programmer who created the software is an expert – the user handling the questions is the end user),

Art Unit: 2193

the computer usable medium comprising: a question generation module configured to generate at least one question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above); a receiving module configured to receive at least one question designed to solicit information from end user relating to a business of the end user (**Profit1**, pages 33 and 228-229, entry is a response to question and **Profit1**, Chapter 2, pages 32 – 36, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership);

a determining module configured to determine whether the business related **complex** software **packages** requires additional information to **implement** the business related **complex** software the computer system of the end user; a linking module configured to provide links to next questions if additional information is determined to be needed to **implement** the business related **complex** software (**Profit1**, page 35, NEXT button on the bottom of screen); for the end user question (**Profit1**, pages 26, 33, and 228-229 as per the select business type); a saving module configured to save the at least one received question (**Profit1**, page 76, finished answering the questions stores the information); and a compiling module configured to write the at least one received question (**Profit1**, page 32-36 as per above) saved by the saving module into the **implementation** software wizard for the end user. (**Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

Claim 13

The computer program product of claim 11, comprising: a help module configured to provide help relating to the at least one question. (**Profit1**, pages 22 – 24, Help on specific topics and page 20, Help button on the selection in Figure 1-13).

Claim 21

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1) by an **expert** for use by a **end user** to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, page 33, Select Business Type Figure 2-1), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1);

entering by the **expert** at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the at least one question entered by the **expert** being designed to solicit at least first information from an end user relating to a business of the **end user** (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1 , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user);

Art Unit: 2193

determining whether additional information relating to the business of the **end user** is necessary to implement a the software package on a computer system of the **end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, page 35, NEXT button on the bottom of screen) ,The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership – more than one question present in article);

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 33, Select Business Type Figure 2-1 and **Profit1**, page 35, NEXT button on the bottom of screen), if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the **end user relating to the business of the end user** (**Profit1**, pages 26, 33 and 228-229, for the selected business type above , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user) **such that the solicited information from the user** is used to set specific options in the **at least one independent module of the software package** (**Profit1**, pages 26, 33, and 228-229 as per the select business type); requiring the solicited information so the **at least one independent module of the software package** can be **implemented** and installed on the computer system of the end user (**Profit1**, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership); and

wherein later addition of independent modules uses the solicited information from the **end user** to ensure the later addition independent modules are implemented consistent with the software package **Profit1**, page 35, NEXT button on the bottom of screen); and at least the first information relating to the business of the **end user** (The intended use of a Installation Wizard as per - Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

Claim 22

The method of claim 21, further comprising the step of generating at least one help definition screen for each edit question screen. (**Profit1**, pages 25 – 28, Help by Topic for Setting Up and Customizing).

Claim 23

The method of claim 21, further comprising the step of providing a default business operating information answer for each generated edit question screen. (**Profit1**, page 48, Default settings – for purchases – Figure 2-11).

Claim 25

The method of claim 21 wherein the determining step includes comparing whether the inputted at least one question solicits all the plurality of business operating information necessary to install the business related software. (**Profit1**, pages 32 to 76 - Starting).

Claim 26

Art Unit: 2193

The method of claim 21, further comprising the step of saving the inputted at least one question and jump information prior to compiling the business software installation application.
(Profit1, page 76, Final Starting decision).

Claim 27

A computer-readable medium having computer executable instructions for performing the acts of claim 1. (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

Claim 28

A computer-readable medium having computer executable instructions for performing the acts of claim 21 (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

Claim 29

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert** for use by a end user to solicit and implement business related data for a software package comprising at least one independent module , the method comprising the steps of:

generating at least one question definition screen ;

entering by the **expert** at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user;

determining whether additional information relating to the business of the end user is necessary to implement a the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information;

if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the **at least one independent module** of the software package requiring the solicited information so the **at least one independent module** of the software package can be implemented and installed on the computer system of the end user and

wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user
(Profit1, as per the rejections for independent claims 1 and 7 above).

Claim 32

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert for use by an end user** to solicit and implement business related data for a **software package** comprising **at least one independent module**, the method comprising the steps of:

Art Unit: 2193

generating at least one question definition screen; entering by the **expert** at least one question on the at least one generated question definition screen, the at least one question entered by the **expert** being designed to solicit at least first information from an end user relating to a business of the end user determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information;

if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be **implemented** and installed on the computer system of the end user; and

wherein later addition of **independent modules** uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user (Profit1, as per the rejections for independent claims 1 and 7 above).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**) as applied to claim 1 above, and further in view of basic use of Encryption as taught by Computer Security Basics from 1991 (Encryption).

Claim 2

Art Unit: 2193

The method of claim 1, including encrypting the stored at least one entered question.

Profit1 teaches the use of passwords (Profit, page 37, Figure 2-4 with controls). Passwords must be stored to enable validation (Profit1, page 37, Assigning passwords for users to access the system requires the storing them) . Encryption teaches encrypting passwords page 65. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the use of passwords of Profit1 with Encryption because access control makes systems secure.

Claim 12

The computer program product of claim 11, comprising: an encryption module configured to provided encryption. As per claim 2.

Claim 24

The method of claim 21, further comprising the step of encrypting the inputted at least one question and jump information. As per claim 2 and Profit1 completing password moving to another screen (Profit, page 37, Figure 2-4 with controls).

12. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of "Setup Factory", User's Guide by Indigo Rose, 1998 (Factory)

Claim 6

The method of claim 4, including the step of: emailing a question to a help reference. (Profit1, page10, Support, phone support) (Factory, page 7, email support). Profit1 shows support via telephone but does not show support by EMAIL. It is Factory who teaches support by email. therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Profit1 and Factory, because email support provides for an easy means of providing hardcopy of help suggestions.

Claim 8

The apparatus of claim 7, wherein the at least one, memory, the at least one monitor, the at least one processing unit, the at least one input device, and compiler are coupled by at least one of a bus protocol, a wireless protocol, an intranet protocol , an extranet protocol, and html protocols. (Factory, page 7, EMAIL over the Internet uses an internet protocol).

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft

Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of USPN # 5,257,377 Sathi et al, October 26, 1993.

Art Unit: 2193

Claim 30

The computer program product of claim 29, further comprising a processor identification module configured to obtain computer system information about the system on which the business software package is being installed (**Sathi**, col 6, line 7 – 20, Processor ID). **Profit1** teaches the installation of software (**Profit1**, Appendix C). What **Profit1** does not teach is the recording of the processor ID the computer the software is installed on. **Sathi** teaches recording the processor ID. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of **Profit1** and **Sathi** because recording the ID of the machine software is installed on provides a means of preventing piracy.

Claim 31

The computer program product of claim 30, wherein the computer information system information includes information necessary to load the computer program. (**Profit1**, Appendix C, Installing Profit)

Response to Arguments**Applicant's Arguments with Response**

"Are claims 1-13 and 21-32 unpatentable under 35 U.S.C. § 102(b) as being anticipated by "The Official Software Companion Microsoft Profit" publication?

The applicants respectfully submit that the Examiner is using impermissible hindsight and assuming the installation wizard product associated with the Profit reference must have been developed using the present invention. However, the Profit reference only instructs regarding how to use the installation wizard and does not provide any information regarding how the wizard screens were generated. Conversely, claim 1 of the present application recites a combination of elements including, for example, "generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user," which generation of at least one question definition screen to facilitate the generation of the screen shown by Profit is not disclosed, suggested, or taught. At most, the Profit reference provides screens to be used by a wizard application designed to solicit information. But the profit reference is completely silent regarding how the screen used by the wizard are generated. Because profit is simply providing instructions on how to use an already generated Wizard product, it has no insight into building the screen in the first place. Conversely, the present claim 1 provides methods, apparatuses, and software to create the screen shown designed to solicit information. In fact, the Examiner does not point to one specific reference where the Profit reference provides any information regarding building the wizard. Because the Profit reference only provides examples for using an existing wizard, it does not show or anticipate "generating at least one question definition screen" or "entering by the expert at least one question on the at least one generated question definition screen." At most, the Profit reference provides a final screen, but does not provide any suggestion or teaching regarding how that screen was developed.

Examiner's Response

Art Unit: 2193

Key to the case is Applicant is looking at the reference PROFIT as if it should be a Programmer's Guide for PROFIT and not the User's Manual where one of ordinary skill in the art can view the programming constructs and functionality and make a determination of patentability.

The screens are evidence of software that has been developed. The controls to move from one screen to another exit, etc are present as claimed. Furthermore, the interpretation of the terms has been given the broadest reasonable interpretation in view of the Specification. Applicant has key terms undefined and has to rely on non germane dictionaries to attempt to breath life into undefined terms.

In terms of generating at least one question is taught by the result. Result being the "Type of Company" that is to use the software is asked. this information is used for the Installation of Profit.

Applicant's argument about the Wizard being "an already generated Wizard product". Has some potential but the claimed invention fails to distinguish over the prior art of record. The presence of the Wizard is proof it was built. Applicant relies on intended use to distinguish the claimed invention. **Intended Use** holds no patentable weight. Applicant would be better off to focus on claim limitations that distinguish the functionality of the Wizard as specified in the Specification to distinguish the invention.

Applicant's Argument

"The Examiner seems to believe the applicants are taking the position that having the source code is the only way to anticipate the present application. However, such is not the case. The applicants are simply requesting the Examiner to point to a reference that discloses methods or apparatuses to develop implementation installation software rather than the implementation software already developed. The original specification, makes clear, the generation of a screen designed to solicit information for use by a wizard may be created in many different ways. The present invention provides a unique way of creating the screens designed to solicit information. The references of record are simply silent regarding the generation of a screen to solicit information. Thus, the applicants respectfully submit that the Examiner is impermissible relying on the teachings of the present application and assuring the screen shown by Profit to solicit information usable by Profit must have been generated using the present invention. Such hindsight is impermissible."

Examiner's Response

Examiner disagrees with the statement on source code. Seem Applicant is requiring the Office to produce a Programmer's Guide for the PROFIT product and not the User's Guide. Applicant might be better off focusing if supported in the Specification on the phases of development and the functionality available to make features available. the focus on the user is not assisting distinguish the claimed invention.

Applicant's Argument

"In particular, the Examiner relies on a disclosure that relates to a software package, more particularly an accounting software: package. To assist in the installation of the software package, the software package is provided with an installation wizard. Applicants do not dispute that the Profit software as detailed more below in fact has an installation wizard. However, as described above, the present invention relates to a method and device for "the development of

Art Unit: 2193

implementation installation software" in the first instance. Conversely, and at most, the Profit software and its associated manuals at most have installation software with screens. They do not disclose, suggest, teach, or even describe "the development of the implementation installation software" nor generating at least one question definition screen, but rather only disclose using such implementation installation software provided. The applicants submit that the references have nothing to do with the development of the installation software, but rather the use of such software. Moreover, many different programming techniques may have been used to develop the installation software, and the applicants respectfully submit that the Examiner is using improper hindsight in view of the present invention to assume the installation software provided must have been developed using the present invention."

Examiner's Response

The fact that the Installation Wizard asks questions to determine the installation of the Accounting package is the installation wizard. Applicant refused to acknowledge this is a commercial available product. Programmers wrote the code that enabled the product taught in the User's Manual.

Applicant's Argument

"Looking specifically to claim 1, it relates to and recites a combination of elements including, for example, a "method in a computer system for enabling the development of implementation installation software by an expert for use by an end user to solicit and implement business related data for a software package comprising at least one independent module, the method comprising the steps of: generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user," which is not disclosed or suggest by the Profit reference. Rather, the Profit reference discloses a software package that happens to have an installation wizard, but provides zero teaching regarding how that installation wizard was developed."

Examiner's Response

Intended Use is given no patentable weight. The programmer(s) who wrote PROFIT meet the claimed limitations. The end result of the development is the generating of questions

Art Unit: 2193

definitions that solicit information. The links to the next questions and other screen controls are present as well. Applicant's argument is based on intended use.

Applicant's Argument

"The present invention as recited by the claims is not directed simply to a software package with an installation wizard but rather the present invention relates (to paraphrase) to the development of the installation wizard for the software package in the first instance. In fact, the difference between prior art and the present invention is clear by looking at the title of the Profit reference. The title of the Profit reference is "Installing Microsoft Profit." In other words, the Profit reference steps you through installing, profit using many windows and dialog boxes that are displayed to gather information from the end user. The Profit reference, however, has no disclosure about development of the installation software, but rather simply uses software already develop, and it is silent regarding the development of the installation software. To the extent the Examiner believes the installation software associated with the Profit reference was developed by generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user" is pure conjecture and using the teachings of the present invention to suppose that the programmers for Profit must have developed the installation software in the same manner. In fact, the applicants are at a loss to find one reference in the Profit reference making any mention of how the installation software, including the screens and dialog, were developed. However, the mere fact that the final installation programs work in a similar manner once develop is insufficient to support a finding of anticipation as the Profit reference does not enable the present invention. (For example, a person may patent a method to make a widget even though the widget is known provided the method is novel and unobvious). The only possible way the Examiner can reach the present conclusion is to use the teachings of the present invention and conclude the installation program for the Profit must have been developed using the present invention. However, this is improper use of hindsight."

Examiner's Response

Art Unit: 2193

Intended use will not distinguish the claimed invention. The end product works in the claimed manner is proof the screens were generated the code was written and compiled. Examiner's suggestions above may assist in avoiding intended use claims.

Applicant's Argument

"Referring specifically to an example provided by the Examiner, the Profit reference at page 26 shows a window displayed during the installation of Profit. The window display happens to have a question and solicits information from an end user. However, the fact that a window exists does not disclose how the screen, question, and dialog box in installation program was generated. "

Examiner's Response

There is no happens to have a window with a question. the product solicits input about the Company for the purpose of custom installation.

Applicant's Argument

"The present invention relates to a method to generate the window displayed on page 26 and not the fact that the window exists. The fact that the window exists does not enable one of skill in the art to make or use the present invention because that window may have been created using a number of different programming techniques, some of which are disclosed in the background of the invention. As mentioned above, the Examiner is using impermissible hindsight to conclude that because the window in the installation software exists, it must have been developed using the present invention. However, that is simply not true."

Examiner's Response

Focusing on the distinguishing functions is the best argument. Examiner hopes this argument being last does not mean there are serious enablement and support issues. This is the best argument.

Applicant's Argument

"The remaining examples from the Profit reference identified by the Examiner show no more than additional window displays from the installation software for profit. The additional examples have no disclosure, suggestion, teaching, or information regarding how those windows were generated. As is clear, claim 1 relates to "the development of implementation installation software," and not to the use of that software once developed, to which Profit reference is directed. Thus, because the profit reference does not disclose, suggest, or teach how the wizard is developed it cannot anticipate the present claim 1. Reversal of the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) is respectfully requested. Claims 7, 11, 21, 29, and 32 contain similar recitations regarding the development of the installation software not disclosed by the Profit reference. Reversal of the Examiner's rejection of claims 7, 11, 21, 29, and 32 under 35 U.S.C. § 102(b) is respectfully requested. Claims 2-6, 8-10, 12, 13, 22-29, 30, and 31 depend from claims 7, 11, 21, and 29. Reversal of the Examiner's rejection of claim 2-6, 8-10, 12, 13, 22-29, 30, and 31 under 35 U.S.C. § 102(b) is respectfully requested.

2. Are claims 2, 12, and 24 unpatentable under 35 U.S.C. 103(a) as being obvious over "The Official Software Companion Microsoft Profit" in view of "Encryption as taught by Computer Security Basics"?

Art Unit: 2193

Claims 2, 12, and 24 depend from claims 1, 7, and 21. The Computer Security Basics does not relate to, disclose, suggest, or teach the development of installation software. Thus, it does not cure the defect of the Profit reference identified above. Thus, reversal of the Examiner's rejection of claims 2, 12, and 24 under 35 U.S.C. § 103(a) is respectfully requested."

Examiner's Response

Under the preponderance of evidence in view of the scope of the present limitations the rejection is maintained.

Applicant's Argument

"3. Are claims 1-13 and 21-32 unpatentable under 35 U.S.C. § 112, first paragraph, because the disclosure is not enabling as "First User" is critical or essential to the practice of the invention but not included in the claim(s) is not enabled by the disclosure?

The Patent Examiner has rejected claims 1-13 and 21-32 under 35 U.S.C. § 112, first paragraph, because the disclosure is not enabling as "First User" is critical or essential to the practice of the invention but not included in the claims) is not enabled by the disclosure." The applicants respectfully traverse this rejection.

Section 216d.08(c) of the MPEP states:

"A feature which is taught as critical in a specification and is, not recited in the claims should result in a rejection of such claim under the enablement provision"

Section 2172.01 of the MPEP states:

"A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling."

Examiner's Response

Intend use is a major issue in the case. Examiner is not encouraging the Applicant to introduce new matter but focus on the development aspect and functional aspects might provide more patentable weight. Nothing precludes one individual from performing all roles.

Applicant's Argument

"The term First User was initially introduced into the claim section of the present application pursuant to a Reply and Amendment filed on April 21, 2005. In introducing the term, the applicants changed the recitation of the phrase "end user" to -- first user --." The designation of "first user" was not provided any special significance and simply provided to indicate that information necessary to install a software package on the computer system of a first user of the software package may be different from the information necessary to install a software, package on the computer system of a second user."

In response to the Reply and Amendment Filed April 21, 2005, the Examiner latched onto the changed terminology and rejected claims 1-13 and 2132 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Moreover, the Examiner indicated the term "First User" was "critical or essential to the practice of the

Art Unit: 2193

invention, but not included in the claim(s) is not enabled by the disclosure. Applicant has redefined the role of end User" to be more than one role."

Believing the rejection to simply confusion, the applicants requested an interview with the Examiner to discuss the terms, meanings, and how best to represent the claims in a manner acceptable to the Examiner. The Examiner denied an interview.

Thus, because the Examiner was unwilling or unable to discuss the 112 rejections, the applicants filed a Reply and Amendment on October 7, 2005, deleting the term "first" and reverting back to the original - end - user recitation. Moreover, the applicants clarified for the Examiner's benefit that "the specification (addresses) a business software implementation installation program that (assists) an owner of the business software by requesting business specific information from the owner. The designations of first user verses second user were to clarify different owners, which clearly has sufficient support to convey to someone of ordinary skill in the art that the present inventors (have) possession of the claimed invention"

Examiner's Response

As the examiner recalls Applicant called at the end of Fiscal year After Final and with just a couple days left in the response period wanted and immediate Interview. It was denied under those circumstances.

Applicant's Argument

"Despite reverting back to the original "end" recitation, the Examiner continued the rejection under 112 in a November 29, 2005 Office Action because, the Examiner stated without any reasonable explanation that "First User" was somehow critical or essential to the practice of the invention. Other than the Examiner's flat statement, the Examiner did not point to any evidence (explicit or implicit) that "First User" was somehow critical or essential to the technology of the application."

Examiner's Response

Introducing new and undefined terms in the middle of prosecution is new matter and lacking critical or essential support.

Applicant's Argument

"Exasperated, the applicants finally reverted to the original claim recitation of "end user." The original recitation was not objected to or rejected by the Examiner. However, the Examiner has finally rejected claims I-13 and 21-32 under 35 U.S.C. § 112, first paragraph, "as based on a disclosure which is not enabling. "First User" critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." It is respectfully submitted that the Examiner has not made a prima facie case the "First User" is critical to the practice of the invention as the Examiner cannot identify "language of the specification (making) it clear that the limitation is critical for the invention to function as intended." (MPEP section 2164.08(c)).

Moreover, the position that "First User" is somehow critical to the practice of the invention is implicitly rebutted by the fact that the original specification and claims did not contain such a recitation. The applicants have reverted to the original language of the application, which was never rejected or objected to by the Examiner.

Art Unit: 2193

Thus, it is respectfully submitted that the claims 1-13 and 21-32 are not unpatentable under 35 U.S.C. § 1 12, first paragraph, because First User is somehow critical and/or essential to the practice of the invention." Thus, the applicants traverse the rejection and respectfully request reversal of the rejection under 35 U.S.C. § 1 12, first paragraph."

Examiner's Response

Intended Use has no patentable weight.

Applicant's Argument

4. "Are claims 7-13 and 21-32 unpatentable under 35 U.S.C. § 112, first paragraph, because "complex software packages" has no support in the specification?

Although the Examiner fails to identify which claims are at issue regarding this rejection, the term "complex" only arises in the above indicated claims. The applicants respectfully traverse this rejection.

Section 2173.05(6) of the MPEP states:

"The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification."

In the original application, the technology was explained in relation to software packages that follow generally accepted accounting principles and standard accounting terms, which the end user and/or information technology person responsible for the software may not understand. "Moreover, the software is often complex and beyond the ability of the end user to properly install the software." An example of such complex software was provided as "the Great Plains Solomon Select/Premier accounting software." Moreover, the software is explained as containing "separate modules, such as general ledges (sic) module, an account receivable module, and accounts payable module, etc. that can be separately installed depending on the company's needs. While each module is typically designed as a functioning unit, may time the modules interact. Because of the complex functionalities of each module and the interactions between the modules, the actual installation of the software typically requires the services of a "software expert" to install the software" The Examiner's "statement that what is what is not complex is not distinct" is incorrect in that the original specification provides a distinct example of what the applicants consider to be complex and why that example is complex. In other words, the original specification is not a mere statement of the word "complex" but rather provides a "standard for measuring the degree" of what is complex by providing a clear example of actual operating software as well as why that example is in fact considered complex software. (MPEP § 2173.05(b)). Because the present application provides one distinct example of a complex software package, a description of what makes that example complex, and a standard by which to measure the degree of complexity, it is respectfully submitted that the term satisfies the requirements of 35 U.S.C. § I 12.

Art Unit: 2193

Moreover, under MPEP section 2173, the office has indicated some latitude in the manner of expression and the aptness of the terms should be permitted even though the claim language is not as precise as the examiner might desire. To the extent the Examiner believes complex software package is not precise enough despite the examples and description in the original specification, the applicants would be willing to consider alternative phrases for the recitations. However, the Examiner has not provided clear articulation of his reasoning other than a bland statement that the term is insufficient. Moreover, although the MPEP encourages examiners to suggest claim language to applicants to improve the clarity of precision of the language used, the Examiner has not provided alternative language.

Thus, it is respectfully submitted that the claims 7-13 and 21-32 are not unpatentable under 35 U.S.C. § 112 because "complex software packages" is defined in the specification by a concrete example, an explanation of why the provided example is considered concrete, and a standard by which to measure the degree of complexity. Thus, the applicants traverse the rejection and respectfully request reversal of the rejection under 35 U.S.C. § 112. Are claims 1-13 and 21-32 unpatentable under 35 U.S.C. § 112, first paragraph, because the term implementing is not enabled?

The term implement was first introduced into the present application by preliminary amendment filed September 16, 2004. The preliminary amendment was tiled to clarify the use of the term "installation." In particular, the preliminary amendment indicated that the term "installation" is understood in the art to mean both load a program onto a computer (i.e., store) and implement the program (i.e., configure for operation) such that it will work on the computer system. This definition is not only the definition of install as accepted in the industry, but as accepted in general common usage. For example, The American Heritage Dictionary of the English Language New College Edition defines "install" as "To set in position and connect [i.e., load] or adjust for use [i.e., configure or implement]." (See The American Heritage Dictionary of the English Language New College Edition 1978 at page 680). A copy of which is attached to Appendix B. The use of installation in the role of implementation (i.e., adjusting) the software package for use is explicit in the specification in that the application is described as soliciting business specific information relating to, for example, accounts receivable, accounts payable and the like verses installation in the role of loading the software package onto a computer system, which would require information such as a storage pathway (such as, for example, C:/programfiles/accounting). It is important to note that the applicants provided this preliminary amendment prior to receiving any action from the US Patent Office relating to this case. As explained in the remarks of the preliminary amendment, the clarification was to expedite the examination of the application due to the applications exceedingly long delay between filing and examination. While the entire specification supports the fact that the term installation includes the subterm implementation, the applications specifically referred to the Examiner to page 6, lines 2 1-26. and pace 7, lines 4-6 and 19-27."

Examiner's Response

The most affective way to overcome such a rejection is to provide a substantive reference from the Art.

Art Unit: 2193

Applicant's Response

"Although the applicants believe implement is at least inherent in the existing application, they are willing to amend the term back to the original term install should the Examiner desire. However, the Examiner has not provided any indication whether this return to the original recitation would be acceptable. Should the Board disagree with the applicants that the term implement is at least an inherent part of installation (as accepted by those of ordinary skill in the art and/or common meaning), it is respectfully request that the Board indicate whether reverting to the original terminology is satisfactory.

Thus, it is respectfully submitted that the claims I-13 and 21-32 are not unpatentable under 35 U.S.C. § 112 because "implement" is defined in the specification. In particular, one of ordinary skill in the art would understand without any additional teaching that installing; a program such as Great Plains Solomon Select/Premier accounting software includes both loading the program onto a computer system and configuring or implementing the system to function once installed. Thus, the applicants traverse the rejection and respectfully request reversal of the rejection under 35 U.S.C. § 112."

Examiner's Response

If Applicant would like to return to their original terms with clarification the meaning. This would be acceptable.

Applicant's Response

"6. Are claims 1-13 and 21-32 unpatentable under 35 U.S.C. 112, first paragraph, because the terms "implementation" and "implement" are not supported by the specification'."

The board is respectfully directed to the argument in paragraph 5 above. The Examiner seems to be requiring one-for-one word correspondence in the application. As explained above, the term installing encompasses the terms loading and implementing. As the original terms installing or install encompasses the term implementing or implement, it is respectfully submitted that the terms are fully supported by the original specification. Moreover, other than a bland statement that the terms fail to satisfy the written description requirement, the Examiner has failed to meet his burden of proof. In particular, the "examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." (MPEP section 2163.00. Moreover, even had the examiner meet this initial burden, the applicants have rebutted the evidence by supplying a dictionary definition that establishes that install include both load or implement. (See The American Heritage Dictionary of the English Language New College Edition 1978 at page 680).

Thus, it is respectfully submitted that the claims 1-13 and 21-32 are not unpatentable under 35 U.S.C. § 112 because "implement" and implementing is supported by the specification. In particular, one of ordinary skill in the art would understand without any additional teaching that installing a program such as Great Plains Solomon Select/Premier accounting software includes both loading the program onto a computer system and configuring or implementing the

Art Unit: 2193

system to function once installed. Thus, the applicants traverse the rejection and respectfully request reversal of the rejection under 35 U.S.C. § 112."

Examiner's Response

Applicant's intended use and many changing roles and new matter leaves the Examiner in no other position but to reject under 112. Who will "implement" and what is the "implementation". There are many mutating or new terms being introduced. In the middle of intended use claims which are given no patentable weight.

Applicant's Response

"7. Are claims I-13 and 21-32 unpatentable under 35 U.S.C. § 112, first paragraph, because the term "independent module" is not supported in the original disclosure and is deemed new matter

The applicants respectfully direct the Board to page 1 of the original specification at lines 21 to 29, stating:

"One such accounting software package is the Great Plains Solomon Select/Premier accounting software. This software contains over 50 separate modules, such as general ledgers module, an accounts receivable module, an accounts payable module, etc., that can be separately, installed depending on the company's needs. While each module is typically designed as a functioning unit, may time the modules interact. Because of the complex functionalities of each module and the interaction between the modules, the actual installation of the software typically requires the services of a "software expert" to install the software"

The Examiner appears not to dispute that this definition adequately defines independent modules, but appears to reject the application on the presumption that the terminology quote only appears in the originally filed provisional application. The Examiner is incorrect in his presumption as the original nonprovisional application contains the above quoted section."

Examiner's Response

Is Applicant saying the quote is present or not?

Applicant's Response

"Thus, it is respectfully submitted that the claims 1-13 and 21-32 are not unpatentable under 35 U.S.C. § 112 because "indepent module" is supported by the specification. In particular, one of ordinary skill in the art of would understand without any additional teaching that installing a program such as Great Plains Solomon Select/Premier accounting software includes both loading the program onto a computer system and configuring or implementing the system to function once installed. Thus, the applicants traverse the rejection and respectfully request reversal of the rejection under 35 U.S.C. § 112.

8. Are claims 1-7 and 29-31 unpatentable under 35 U.S.C. § 112, first paragraph, because the following limitations are not supported by the specification: (a) "wherein later addition of independent modules uses the solicited information from the non-expert user to ensure the later addition

Art Unit: 2193

independent modules are implemented consistent with the software package and at least the first information relating to the user", (b) "intermediate user", and "ensuring"?

Regarding "intermediate user," the term was originally proposed to distinguish between the individual generating the questions during the builder portion of the application and the "end user" from which business related information is obtained. The term was originally introduced in the aforementioned preliminary amendment without objection or rejection from the patent Examiner. The term has existed in claim 7 throughout every rejection that the Examiner has made in this case notably without any object or rejection to the term. Now - after a long prosecution history -- the Examiner is indicating that "intermediate user" is unsupported- However., as is clear from the specification, the present application requires a expert software programmer to generate questions to solicit information regarding the end user's business. Intermediate is simply a phrase to designate one verses the other. It seems the Examiner is requiring verbatim word usage between the written description and the claims, which is not required. Moreover, the Examiner indicates "intermediate user" was deleted from claims 21 and 29. This is incorrect as those claims recited -intermediate expert user --. The applicant deleted intermediate because sufficient distinction exists between "expert user" and "end user" that the addition of intermediate provided no further clarification. The Examiner appears to confuse the deletion of intermediate from - intermediate expert user - as an admission that - intermediate user - is not supported by the original specification. However, the application clearly discloses a business owner as the end user from who business related information is sought and a previous user who generates the questions to solicit the proper business related information.

The Examiner has similarly improperly rejected the phrase "ensure the later addition independent modules are implemented consistent with the software package." However, at page 11 lines 30-32 of the original specification, the application clearly states that prior to requesting any information "information could be retrieved as part of the setup procedure-" Thus, to the extent certain information is already stored in memory, such as, for example, accounts receivable names, the process retrieves that information prior and populates fields prior to soliciting additional information. Moreover, using earlier solicited information and/or updating previously installed modules with new information is an inherent or necessary quality of using the present invention and as such is not new matter or unsupported by the original disclosure. Apparently, the Examiner concedes this statement is fact be supported as the Examiner states:"

Examiner's Response

The last argument looks like more intended use arguments. Examiner hopes some of the comments above may provide a direction in which the claims may go. The focus on intended use is not distinguishing the invention.

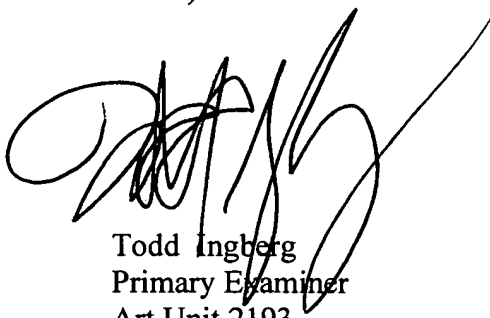
Correspondence Information

Art Unit: 2193

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Todd Ingberg
Primary Examiner
Art Unit 2193

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